REMARKS

By this amendment, claims 4, 6, and 41 have been amended. Claims 1-60 are pending in the application. Applicant reserves the right to pursue the original claims and other claims in this and other applications.

The Office Action states that that claims 5, 7-26, 28, 42-45, 47, and 55-60 are withdrawn from further consideration as being drawn to a nonelected species, there being no allowable generic or linking claim. However, Applicant respectfully submits that claims 1-4, 29-40, and 49-54 are generic as stated in the Office Action mailed November 7, 2005.

Claims 4, 6, and 41 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 has been amended to be dependent on claim 3. Claims 6 and 41 have been amended as shown above to address the concerns raised in the Office Action. Applicant respectfully requests that the rejection of claims 4, 6, and 41 be withdrawn.

Claims 1-3, 27, 29-33, 35-39, 46, 48-52, and 54 stand rejected under 35 U.S.C. § 102(a) as being anticipated by EP 1,329,432A1 ("Tsunetomo"). This rejection is respectfully traversed.

Claim 1, recites, *inter alia*, "providing an etchant in the first opening to etch both the substrate and the first layer to form a first mold for a first micro-lens, the etchant etches the first layer at a different rate than the substrate." Tsunetomo does not disclose this feature. To the contrary, Tsunetomo discloses that a "Cr film 30 is formed on a surface of the SiO_2 layer" and that "the Cr layer is used as a mask." (column 6, lines 34-40). The Cr layer is then removed after the etching is completed (column 6,

lines 45). Therefore, it is clear that Tsunetomo does not teach "providing an etchant in the first opening to etch *both* the substrate and the first layer" as recited by claim 1, but instead, only teaches etching the SiO_2 layer. Further evidence of this may be found in FIG. 5, where it can be seen that the size of the hole 32 in the Cr layer 30 does not change through out the etching process shown in FIG. 5C.

Claim 38, recites, *inter alia*, "forming an opening in the first and at least one second layers" and "providing an etchant in the opening to etch the substrate, the first layer, and the at least one second layer to form a mold for a micro-lens." Tsunetomo does not disclose these features. To the contrary, Tsunetomo discloses that "a Cr film is deposited, and a mask 3 is made of Cr" (column 10, lines 44-45). The Cr layer is then removed after the etching is completed (column 10, lines 57-58). Therefore, it is clear that Tsunetomo does not teach "providing an etchant in the opening to etch the substrate, the first layer, and the at least one second layer to form a mold for a micro-lens" as recited by claim 38, but only teaches etching the SiO_2 layer and the homogenous layer 2. Further evidence of this may be found in FIG. 9, where it can be seen that the size of the hole 32 in the Cr layer 3 does not change through out the etching process shown in FIG. 9B and FIG. 9C. Furthermore, Tsunetomo does not teach "forming an opening in the first and at least one second layers" as recited by claim 38, but instead only teaches forming an opening in the mask 3 (column 10, lines 43-45).

Since Tsunetomo does not disclose all the limitations of claims 1 and 38, claims 1 and 38 are not anticipated by Tsunetomo. Claims 2-37 depend from claim 1 and are patentable at least for the reasons mentioned above. Claims 39-54 depend from claim 38 and are patentable at least for the reasons mentioned above. Applicant respectfully requests that the 35 U.S.C. § 102(a) rejection of claims 1-54 be withdrawn.

Claims 34 and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsunetomo in view of U.S. Patent No. 5,708,493 ("Ahsbabs"). This rejection is respectfully traversed.

Claims 34 and 53 depend from claim 38, which is allowable over Tsunetomo at least for the reasons discussed above with respect to the rejection under 35 U.S.C. § 102(a).

Furthermore, the Office Action fails to establish a *prima facie* case of obviousness at least because the Office Action has not provided proper motivation to combine the references. To establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office Action states that "[i]t would have been obvious to one skilled in the art to use the mold of Tsunetomo to make inorganic lenses because Ahsbabs teaches that molding may be used to make organic and inorganic lenses and inorganic lenses are known to be more scratch resistant than their organic counterpart. Also because Tsunetomo's mold is made from inorganic material it could withstand the processing conditions used for inorganic lenses." (Office Action, page 4).

Applicants respectfully submit that the above statements merely describe one advantage of inorganic lenses over organic lenses, but do not explain why one of ordinary skill in the art would be motivated to combine the process of Tsunetomo with the raw material taught by Ahsbabs to produce inorganic lenses when Ahsababs

already discloses a process to make inorganic lenses. Therefore, this statement does not provide proper motivation to combine the process of Tsunetomo with the raw materials taught by Ahsbabs. Furthermore, assuming *arguendo* that the mold taught by Tsunetomo is capable of producing inorganic lenses as stated by the Office Action, the fact that the process would be capable of producing inorganic lenses is not motivation to do so. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicant respectfully requests that the rejection of claims 34 and 53 be withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

By _____

Thomas J. D'Amico
Registration No.: 28,371
David T. Beck
Registration No.: 54,985
DICKSTEIN SHAPIRO LLP
1825 Eye Street NW
Washington, DC 20006-5403
(202) 420-2200
Attorneys for Applicant